

REMARKS

In response to the Office Action mailed on October 18, 2005, the Applicants have amended claims 16, 21, 28-29, 32-33, 41, 43-52, and 54. Claims 1-9, 13-16, 21-26, 28-30, 32-54, and 56-67 are pending and claims 10-12, 17-20, 27, 31, and 55 are withdrawn from examination.¹

Claim Rejections under 35 U.S.C. §112

The Examiner rejected to claims 16 and 21 under 35 U.S.C. §112. Applicants amended claims 16 and 21 to obviate these rejections, so the rejections should be withdrawn.

Claim Rejections under 35 U.S.C. §103

Claims 1-9, 13-16, 21-26, 28-30, 32-54, and 56-67 have been rejected under 35 U.S.C. 103(a) as being unpatentable over David (WO9959096) in view of Frost (U.S. 5,041,972) and further in view of one or more of A Review of Conjoint Analysis (DSS Research Publication), Revashetti (U.S. 6,453,347), and Individual Hybrid Models for Conjoint Analysis (Paul et al).

Claim 1

The office acknowledges that "David and Frost do not explicitly disclose the use of conjoint data." (office action, page 4, lines 1-2). The examiner relies on the DSS Research publication as teaching the use of conjoint survey data. The office action takes the position that it would have been obvious to modify David and Frost to incorporate the conjoint survey in the DSS Research publication. However, there is no motivation to combine the three references.

For example, Frost provides a system in which users rate an attribute for a product on a scale of 0-10. The relationship between multiple products is then evaluated using a Euclidian distance between the survey responses for the different items (col. 4, lines 57-65). For the sake of argument, even if the DSS Research publication disclosed the use of conjoint survey data

¹ Applicants note that the examiner lists claims 1-9, 13-17, 21-30, 32-54, and 56-57 as currently pending. However, in response to the office action mailed on May 5, 2005 the applicants provisionally elected claims 1-9, 13-16, 21-26, 28-30, 32-54, and 56-67 and withdrew claims 10-12, 17-20, 27, 31, and 55.

concerning the consumer experience, it would not have been obvious to one of ordinary skill in the art to incorporate use of such conjoint survey data into the methods disclosed in Frost. For instance, there is nothing to suggest that it would be desirable to modify the data analysis using Euclidian distances between different survey results to use conjoint data to produce marketing analytics as recited in claim 1.

Furthermore, even if there were a motivation to modify Frost to use conjoint data, the references do not teach how such a modification would be made. The rejection of claim 1 is a hindsight reconstruction, using applicant's claim as a template to reconstruct the invention by picking and choosing isolated disclosures from the prior art. This is impermissible under the law. For example, in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600)

The present rejection fits the court's description of what may not be done under § 103. The examiner has merely listed certain components of applicant's invention and then located isolated disclosures of those components. The law requires more than that.

The examiner must show where the prior art provides a motivation to combine the references he/she has combined in the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As the Federal Circuit stated in *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990):

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

Claims 2-7, 38-42 and 51-57, which depend from independent claim 1, are patentable for at least the same reasons that independent claim 1 is patentable.

Dependent claim 41

Claim 41 has been rejected under 35 U.S.C. §103(a) as being unpatentable over David in view of Frost, and the DSS Publication as applied to claims 1, 8, and 15 and further in view of Paul (Individual Hybrid Models for Conjoint Analysis). The examiner has not provided any comments in response to the applicant's arguments submitted on February 3, 2005 that Paul fails to disclose or suggest the features of claim 41.

The office action acknowledges that David, Frost and the DSS Publication fail to teach calculating a total utility analytic and relies on Paul to provide what is missing.

The applicant's total utility analytic is described for example on page 15 of the specification as follows:

The average total utility 622 is determined by first calculating the utility for each product. The utility is based on values the respondents to the conjoint survey placed on each attribute of each product... Second, each utility value produced by each respondent is then divided by the number of respondents. The total utility analytic provides a measurement that allows the user to evaluate at the highest level the brand performance of the user's product compared to the competitor's product.

The applicant has amended claim 41 to further define the total utility analytic. As amended claim 41 recites "processing at least the conjoint survey data to produce marketing analytics includes calculating a total utility analytic based on conjoint survey data received from multiple respondents." Paul discloses a method in which a decision maker rates the desirability of a set of attributes on a scale from 0-10 (page 951, col. 1, lines 17-19) and the same decision maker rates the importance of each attribute on a scale from 0-10 (page 851, col. 1, lines 20-21). The utility measure disclosed in Paul is the sum of the weighted desirabilities with both sets of inputs supplied by the individual decision maker. Paul's calculation is different that the recited "total utility analytic" that is calculated "based on conjoint survey data received from multiple respondents" at least because it is not based on data received from multiple respondents. Therefore, Paul fails to disclose or suggest "processing at least the conjoint survey data to produce marketing analytics includes calculating a total utility analytic based on conjoint survey data received from multiple respondents" as recited in claim 41.

Dependent claim 42

In the response submitted by the Applicant on February 3, 2005, the applicant requested that the examiner provide support for this position that it would have been obvious to a person of ordinary skill in the art to receive the data in real time. In response, the examiner grouped the rejection of claim 42 with the rejection of claim 1 but failed to provide support for his position regarding the receipt of data in real time. The applicant again requests that the examiner provide support for this position as required by MPEP 2104.04.

Dependent claim 52

The Applicant's claim 52 recites a system that includes instructions for causing the computer system to "process the conjoint survey data concerning consumer experience with a brand in real-time."

The examiner groups the rejection of claim 52 with the rejections of claims 41, 46, 51, 53-54, and 56-57. However, the examiner fails to address the limitations of claim 52. Specifically, the examiner fails to provide support for his position that Paul teaches a system to "process the conjoint survey data... in real-time."

If this rejection is to be maintained, the applicant requests that the examiner provide documentary support for the rejection.

Dependent claim 53

The Applicant's claim 53 recites a method for calculating a total utility analytic that includes "calculating a utility value for a product and dividing the utility value by the number of respondents." The office action acknowledges that David, Frost and the DSS Publication fail to teach calculating a total utility analytic. In addition, Paul fails to disclose or suggest calculating a utility analytic using the method of claim 53.

As described above, the utility measure disclosed in Paul is the sum of the weighted desirabilities of two sets of inputs supplied by the decision maker (e.g., the desirability of a set of attributes and the importance of each attribute). Thus, Paul fails to disclose or suggest

“calculating a utility value for a product and dividing the utility value by the number of respondents” as recited in claim 53.

Dependent claim 54

The Applicant's claim 54 depends from claim 53 and further recites a method for calculating a total utility analytic that includes “summing the values the respondents place on each attribute of the product.” The office action acknowledges that David, Frost and the DSS Publication fail to teach calculating a total utility analytic in this manner. In addition, Paul fails to disclose or suggest calculating a utility analytic using the method of claim 54.

As described above, the utility measure disclosed in Paul is the sum of the weighted desirabilities of two sets of inputs supplied by the decision maker (e.g., the desirability of a set of attributes and the importance of each attribute). Thus, Paul fails to disclose or suggest “summing the values the respondents place on each attribute of the product” as recited in claim 54.

Dependent claim 56

The Applicant's claim 56 recites a method in which “receiving at least conjoint survey data concerning consumer experience with a brand is performed in real-time and includes receiving conjoint survey data based on questions that have been adapted based on previous responses.”

The examiner groups the rejection of claim 56 with the rejections of claims 41, 46, 51-54, and 57. However, the examiner fails to address the limitations of claim 56 in this rejection. Specifically, the examiner fails to provide support for his position that Paul teaches “receiving conjoint survey data based on questions that have been adapted based on previous responses.”

If this rejection is to be maintained, the applicant requests that the examiner provide documentary support for the rejection.

Independent claims 8, 15, 26, 30, and 34

Independent claims 8, 15, 26, 30, and 34 include similar limitations to claim 1 and are patentable for at least the reasons discussed above. Claims 9-14 depend from independent claim

Applicant : Stephen F. Dull et al.
Serial No. : 09/909,955
Filed : July 20, 2001
Page : 16 of 16

Attorney's Docket No.: 12587-020001 / 01330-00/US

8, claims 16-21 depend from independent claim 15, claims 27-29 depend from independent claim 26, claims 31-33 depend from independent claim 30, and claims 35-37 depend from independent claim 34, and are patentable for at least the same reasons that independent claims 8, 15, 26, 30 and 34, respectively, are patentable.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance, and such action is respectfully requested.

Summary

The applicant asks that all claims be allowed.

The fact that the applicant has addressed certain comments of the examiner does not mean that the applicant concedes any other positions of the examiner. The fact that the applicant has asserted certain grounds for the patentability of a claim does not mean that there are not other good grounds for patentability of that claim or other claims.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 2/17/06



Tonya S. Drake
Reg. No. 57,861

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
21236367.doc